

REMARKS

This is a full and timely response to the outstanding non-final Office Action mailed September 16, 2005. Reconsideration and allowance of the application and pending claims are respectfully requested.

I. Claim Rejections - 35 U.S.C. § 102(b)

Claims 1-25 have been rejected under 35 U.S.C. § 102(b) as being anticipated by Okada, et al. ("Okada," U.S. Pat. No. 6,088,125). Applicant respectfully traverses this rejection.

It is axiomatic that "[a]nticipation requires the disclosure in a single prior art reference of each element of the claim under consideration." *W. L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1554, 220 USPQ 303, 313 (Fed. Cir. 1983). Therefore, every claimed feature of the claimed invention must be represented in the applied reference to constitute a proper rejection under 35 U.S.C. § 102(b).

In the present case, not every feature of the claimed invention is represented in the Okada reference. Applicant discusses the Okada reference and Applicant's claims in the following.

Before addressing the merits of the Okada reference and Applicant's claims, Applicant objects to the rejection as being improper. Specifically, the rejection only addresses claim 1 and says *nothing* of Applicant's other 24 originally-filed claims. Those other claims contain limitations not present in claim 1 and, therefore, the Examiner has failed to address all of Applicant's claim limitations. In view of the above, Applicant asserts that any further Office Action, if issued, should be non-final.

A. The Okada Disclosure

Okada discloses a facsimile machine and communication result notifying method. Okada, Patent Title. In one embodiment, Okada describes a method of notifying as to printing. Okada, column 10, line 66 to column 11, line 2. As is described by Okada, that method comprises printing a document, detecting the result of the printing process, and sending a notification to an email address previously registered with the printing device. Okada, column 11, lines 33-44.

Significantly, Okada says nothing about “print-to-mail format documents” or identifying “attributes” of print-to-mail format documents.

B. Applicant’s Claims

1. Claims 1-11

Applicant’s claim 1 provides as follows (emphasis added):

1. A method for print-to-mail notification, comprising:
determining that a print-to-mail format document has been *printed, folded, and sealed as a mailing*;
identifying attributes of the print-to-mail format document; and
generating notification information *that identifies that the print-to-mail format document has been printed, folded, and sealed as a mailing*.

As is described above, Okada says nothing of print-to-mail format documents. Accordingly, Okada does not teach any of the above limitations, which each explicitly

describes a “print-to-mail format document”. In an effort to clarify what is meant by that term, Applicant has amended claim 1 to explicitly recite determining that a print-to-mail format document has been “printed, folded, and sealed as a mailing”. Okada does not teach anything of the sort. Claim 1 is allowable over Okada for at least that reason.

As a further matter, Applicant notes that Okada fails to teach “identifying attributes of the print-to-mail format document”. Specifically, Okada does not describe identifying attributes of any document that was printed.

2. Claims 12-17

Applicant’s claim 12 provides as follows (emphasis added):

12. system for print-to-mail notification, comprising:
means for determining that a print-to-mail format document has
been *printed, folded, and sealed as a mailing*;
means for identifying attributes of the print-to-mail format
document; and
means for generating notification information *that identifies that*
the print-to-mail format document has been printed, folded, and sealed
as a mailing.

Regarding claim 12, Okada does not teach “means for determining that a print-to-mail format document has been printed, folded, and sealed as a mailing”, “means for identifying attributes of the print-to-mail format document”, or “means for generating notification information that identifies that the print-to-mail format document has been

printed, folded, and sealed as a mailing”, at least for reasons described above. Claims 12-17 are allowable over Okada for at least those reasons.

3. Claims 18-25

Applicant’s claim 18 provides as follows (emphasis added):

18. A print-to-mail device, comprising:
a processing device;
hard copy generation hardware;
a folding mechanism;
a sealing mechanism; and
memory including a print-to-mail notifier configured to generate notification information ***pertinent to printing, folding, and sealing of a print-to-mail format document as a mailing.***

Regarding claim 18, Okada does not describe print-to-mail functionality and therefore does not teach a “print-to-mail device” that comprises a “folding mechanism” and a “sealing mechanism”. As a further point, Okada does not teach a “print-to-mail notifier” configured to generate notification information pertinent to “printing, folding, and sealing of a print-to-mail format document as a mailing”, at least for reasons described above. Claims 18-25 are allowable for at least the above reasons.

II. Canceled Claims

Claim 20 has been canceled from the application without prejudice, waiver, or disclaimer. Applicant reserves the right to present that canceled claim, or variants thereof, in continuing applications to be filed subsequently.

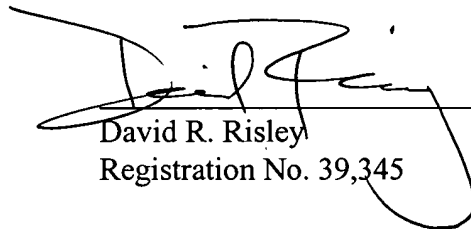
III. New Claims

Claims 26-32 have been added into the application through this Response. Applicant respectfully submits that these new claims describe an invention novel and unobvious in view of the prior art of record and, therefore, respectfully requests that these claims be held to be allowable.

CONCLUSION

Applicant respectfully submits that Applicant's pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,



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